

REMARKS

This paper is responsive to a Final Office Action mailed March 18, 2008. Prior to this response, claims 1-27 were pending. Claims 1-27 remain pending.

In Section 5 of the Office Action claims 1, 3-14, and 16-27 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Nishikawa et al. ("Nishikawa"; US 6,934,046) in view of Barry et al. (US 7,099,027). With respect to claims 1 and 14, the Office Action acknowledges that Nishikawa fails to disclose merger performance analysis, or determining if the joining of print jobs exceeds the job joining overhead. The Office Action states that Barry discloses an algorithm for making routing decisions on the basis of cost, time, and economy, and that it would have been obvious to combine references, based upon an economic motivation. This rejection is traversed as follows.

Nishikawa discloses a print system that converts all print instructions into an intermediate code that is output to the spooler file 303 and called a page description file (PDF), see col. 7, ln. 52-55 and col. 8, ln. 14-18. Once it is determined that a printing operation is to be performed, the spool file sends the PDF to the despooler 305 where the GDI function is regenerated (col. 8, ln. 40-46). The Applicant submits that Nishikawa is describing EMF spooling – a process that defers print data generation until after the jobs have been joined together.

Barry discloses a process block 2106 that determines how a job is to be routed or processed, based upon printer availability, predetermined scheduling, speed, and cost (col. 26, ln. 3-20). An algorithm uses information in the PDL file to permit routing decisions to be performed upon the basis of metrics such as cost and speed (col. 31, ln. 49-65). Thus, Barry describes a *routing* analysis performed on a *single* job. Barry does not disclose a document joining analysis. More explicitly, Barry does not disclose determining the overhead associated with joining a plurality of jobs, and Barry does not disclose determining if the jobs can be economically joined on the basis of the overhead analysis.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggests 7 exemplary rationales to support a conclusion of obviousness, which include:

A) Combining prior art elements according to known methods to yield predictable results;

B) Simple substitution of one known element for another to obtain predictable results;

C) Use of known technique to improve similar devices (methods, or products) in the same way;

D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that modifications to Nishikawa would have been obvious to one of ordinary skill in the art in light of Barry. This rejection appears to be most closely grounded in the G) rationale - Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

With respect to this rationale, MPEP 2143 (G) states that the rejection must articulate the following criteria to resolve the *Graham* factual analysis:

(1) a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings;

(2) a finding that there was a reasonable expectation of success; and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

With respect to the above-referenced first factual analysis criteria, the Barry reference has been combined with Nishikawa based upon the assumption that the combination discloses every limitation recited in Applicant's claims 1 and 14. However, neither Nishikawa nor Barry discloses a process that performs a job joining analysis, to determine if the economy of joining the jobs exceeds the overhead associated with joining. The Office Action acknowledges that Nishikawa fails to disclose a job joining or job joining overhead analysis. As noted above, Barry merely performs a printer routing analysis for a single print job. Therefore, even if elements from Barry are combined with Nishikawa, that combination does not explicitly disclose every limitation of claims 1 and 14. Claims 3-13, dependent from claim 1, and claims 16-27, dependent from claim 14, enjoy the same advantages.

The Office Action states that the motivation to combine references would have been to save money by having a predetermined algorithm based upon economics. However, this assertion does not explain how the combination of references suggests limitations that are recited in the claimed invention, but missing in both the Nishikawa and Barry references. Neither reference discusses the measurement of overhead associated with joining print jobs. Without the suggestion, or means of performing this overhead analysis, the combination of references cannot be said to suggest the joining of a plurality of print jobs on the basis of economy.

A *prima facie* analysis of motivation is especially critical in the present circumstances since the rejection is predicated on limitations

that are not explicitly disclosed in the prior art references. The claimed invention can only be obvious if an artisan makes substantial modifications to the Nishikawa reference. However, there is nothing in the Barry reference that suggests that there is a potential economy to joining a plurality of print jobs, or that this potential economy can be traded-off against considerations of job joining overhead.

Neither does the obviousness rejection provide evidence that such modifications would have been obvious to one with skill in the art based upon what was well known at the time of the invention. “(A)nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art then additional evidence should have been provided. Notable, when the source or motivation is not from the prior art references, “the evidence” of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Office Action does not supply evidence that it was well known at the time of the invention to perform a job joining analysis, or a calculation of job joining overhead.

With respect to the second analysis criteria needed to support the G) obviousness rationale, even if a practitioner were given the Nishikawa and Barry references as a foundation, no evidence has been

provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of success if the references, and what was known by artisan at the time of the invention, do not teach all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of Nishikawa and Barry does not explicitly disclose every limitation of claims 1 and 14. Neither has a case been supported that Nishikawa can be modified to supply the missing limitations in view of Barry, or what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 1, 3-14, and 16-27 be removed.

In Section 6 of the Office Action, claims 2 and 15 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Nishikawa and Barry in view of Reilly (US 6,052,147). The Office Action acknowledges that Nishikawa and Barry fail to disclose a print server, but that Reilly discloses such a feature, and that it would have been obvious to combine references, with the motivation being that the combination of a printer and print server reduces costs. This rejection is traversed as follows.

The Reilly reference has been combined with Nishikawa/Barry predicated upon the assumption that the combination of Nishikawa and Barry discloses all the limitations of independent claims 1 and 14. However, as noted above in the discussion of claims 1 and 14, the combination of Nishikawa/Barry fails to disclose an analysis of job joining economies or the calculation of the overhead associated with joining a

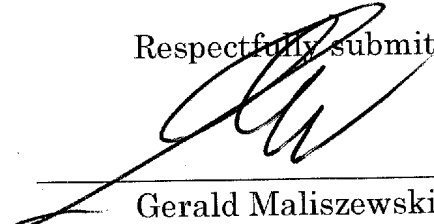
plurality of jobs. Therefore, even if Reilly is combined with Nishikawa/Barry, the combination still fails to disclose the above-mentioned limitations. Claim 2, dependent from claim 1, and claim 15, dependent from claim 14, enjoy the same advantages.

The Office Action states it would have been obvious to combine a printer and print server to reduce costs. However, this statement does not explain how a practitioner in the art could have modified the references to yield all the claimed invention limitations. As explained above, even when combined, Reilly, Nishikawa, and Barry fail to disclose all of the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could have modified Nishikawa's conventional job joining process to enable a process that optionally joins jobs on the basis of a job joining overhead analysis, since neither Reilly nor Barry describe or suggest these limitations. Alternately stated, the motivation to supply all the limitations missing in the references cannot be inspired by a desire to reduce costs. Such an assertion does not explain how a practitioner could have arrived at the Applicant's claim limitations to achieve the goal of reducing costs. Rather, there must be an explicit teaching in the Reilly reference that shows a practitioner how Nishikawa/Barry can be modified to yield the claimed invention. Such a *prima facie* case has not been made.

Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Nishikawa that would make all the limitations obvious, the Applicant requests that the rejection of claims 2 and 15 be withdrawn.

Applicant asserts that the claims are patentable over the references made of record. It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

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